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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,465	08/23/2001	John R. Milton	10010979-1	4080

7590 10/20/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

CORRIELUS, JEAN M

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/938,465

Applicant(s)

John R. Milton

Examiner

Jean M Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The office action is in response to the application filed on August 23, 2001, in which claims 1-23 are presented for examination.

#### *Drawings*

2. Applicants are required to furnish the formal drawings in response this office action. No new matter may be introduced in the required drawing. Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrel et al (hereinafter "Ferrel") US Patent no. 5,907,837, Krishna et al., (hereinafter "Krishna") US Patent no. 6,012,071 and Daniel US Patent Publication no. 2003/0163784.

As to claim 1, Ferrel discloses the claimed "detecting at least one placement tag with the content element in a computer system, the content element comprising at least a portion of a content item to be placed in the publication" retrieving content from the publication and the layout that satisfy user query (col.4, lines 26-63; col.9, lines 27-45; col.14, lines 48-56; col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52). However, Ferrel does not explicitly disclose the use of

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“determining at least one position in the publication at which the content element is placed when the at least one placement tag is detected”. Krishna discloses an analogous electronic publishing system that employs servers to store electronic publication. In particular, Krishna discloses the claimed “determining at least one position in the publication at which the content element is placed when the at least one placement tag is detected” (col.10, lines 61-67; col.11, lines 1-9). It would have been to one having ordinary skill in the art at the time the invention was made to combine the teaching of the cited references. One having ordinary skill in the art would have found it motivated to utilize such a combination would allow Ferrel’s system the enhanced capability of finding the location of content in the publication, thereby providing easy access the content of interest.

Neither Ferrel nor Krishna discloses the use of generating a placement report that logs the at least one position of the content element within the publication. On the other hand, Daniel discloses the claimed “generating a placement report that logs the at least one position of the content element within the publication” (page 8, paragraph [0078]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching the teaching of the cited references. One having ordinary skill in the art would have found it motivated to utilize such a combination would allow Ferrel and Krishna’s system the enhanced capability of generating a report as to where the content item placed in the publication, thereby the content element of the publication can be easily arranged, updated and deleted without having to make any changes to the remainder of the publication.

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As to claim 2, Ferrel discloses the claimed “placing the content item in the at least one position in the publication” (col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52).

As to claims 3-4, Daniel discloses the claimed “identifying a placement report identifier associated with the at least one placement tag “ and “writing the placement report identifier to the placement report (page 8, paragraph [0078]).

As to claim 5, Ferrel discloses the claimed “drawing an association between the at least one placement tag and the content element” (col.4, lines 26-63; col.9, lines 27-45; col.14, lines 48-56; col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52).

As to claim 6, Ferrel discloses the claimed “identifying the at least one placement tag as an attribute associated with the content element” (col.4, lines 26-63; col.9, lines 27-45; col.14, lines 48-56; col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52).

As to claim 7, Ferrel discloses the claimed “identifying the content element encapsulated between a pair of placement tags” (col.4, lines 26-63; col.9, lines 27-45; col.14, lines 48-56; col.8, lines 45-67; col.19, lines 45-67; col.21, lines 42-52).

As to claims 8-23, the limitations of claims 18-23 have been detailed in the rejection of claims 1-7 above. They are, therefore, rejected under the same rationale.

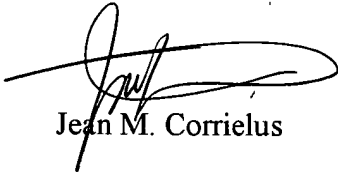
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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (703) 306-3035. The examiner can normally be reached on Monday - Friday (12:00pm - 7:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M. Corrielus

Patent Examiner

October 7, 2004